

DOCKET NO: 259189US40PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MOTOO ASAI, ET AL. : EXAMINER: JAHAN, BILKIS
SERIAL NO: 10/509,899 :
FILED: JUNE 29, 2005 : GROUP ART UNIT: 2814
FOR: SUBSTRATE FOR MOUNTING IC :
CHIP, MANUFACTURING METHOD OF
SUBSTRATE FOR MOUNTING IC CHIP,
DEVICE FOR OPTICAL
COMMUNICATION, AND
MANUFACTURING METHOD OF
DEVICE FOR OPTICAL
COMMUNICATION

**RESPONSE TO RESTRICTION AND
ELECTION OF SPECIES REQUIREMENTS**

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement stated in the Official Action dated April 2, 2008, Applicants elect Group (Invention) II, Claims 1-11, 17-32, 34-40, 42-49 and 51-64, drawn to IC substrate and optical communication device classified in class 257, subclass 738. Furthermore, in response to the Election of Species Requirement stated in the same Official Action, Applicants provisionally elect Species 1, drawn to IC substrate, and identify Claims 1-11 as readable on the elected Species.

However, Applicants respectfully traverse the outstanding Election of Species Requirement for the following reasons.

The outstanding Office Action simply states that “[t]he species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of

such species” and that “these species are not obvious variants of each other based on the current record,” but it does not provide further information. It is respectfully submitted that without further information, the aforementioned findings are believed to lack grounds upon which it can be evaluated whether in fact the required distinctness and reasons for insisting on election are established. Accordingly, it is respectfully submitted that the PTO has not carried its burden of proof to establish distinctness.

Furthermore, MPEP §803 states the following:

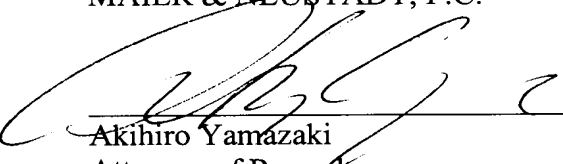
If the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

In the present application, Claims 1-11 and 51-64 are directed to substrates for mounting an IC chip and Claims 17-32, 34-40 and 42-49 are directed to devices for optical communication including a substrate for mounting an IC chip. Hence, it appears that all the pending claims in the present application are part of an overlapping search area and that a search for Claims 1-11 would necessarily include classes and/or subclasses required for a search directed to Claims 17-32, 34-40, 42-49 and 51-64 as well. It is therefore believed that there is no undue burden on the Examiner to search all claims under MPEP §803, and Applicants respectfully traverse the Election of Species Requirement on the grounds that a search and examination of all the claims in the present application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the outstanding Election of Species Requirement be withdrawn, and that a full examination on the merits of each of Claims 17-32, 34-40, 42-49 and 51-64 be conducted.

Respectfully submitted,

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